

REMARKS

This application has been reviewed in light of the Office Action dated April 17, 2006, and the Advisory Action dated August 11, 2006. Claims 1-10, 12-27, 29-30, 32, and 36-40 are pending, of which Claims 1, 30, and 36-39 are in independent form. Claim 11 has been cancelled, without prejudice or disclaimer of the subject matter presented therein, and Claims 28, 31, and 33-35 were previously cancelled. Independent Claims 1, 8, 10, 12, 16, 17, 30, and 36-39 have been amended to clarify the claimed features. Applicants submit that the changes to the claims do not narrow their scope. Favorable consideration is requested.

In the Office Action of April 17, 2006, the Examiner rejected Claims 1-4, 6-30, 32, and 36-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,336,099 (“Barnett”), and rejected Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Barnett. Applicants submit that independent Claims 1, 30, and 36-39, together with the claims dependent therefrom, are patentably distinct from Barnett for at least the following reasons.

Claim 1 is directed to a method for motivating a consumer to promptly purchase a product and/or a service electronically over a computer network. According to the method, a program is provided from a server over the computer network to a consumer’s computer. The program causes the consumer’s computer to display an offer for sale of a product and/or a service that may be purchased immediately via the computer network. The program also causes the consumer’s computer to concurrently display an incentive for promptly purchasing the product and/or service. The incentive is set to an initial displayed value that changes over a period of time to at least one other displayed value.

When the consumer makes an electronic purchase of the product and/or service by electronically accepting the offer, the program provides to the server an indication of acceptance

and a current displayed value of the incentive. An initial time at which the incentive is displayed and an acceptance time at which the consumer electronically accepts the offer are registered at the server. The initial time and the acceptance time are compared to verify the current displayed value of the incentive provided to the server. The incentive is electronically redeemed for the verified current displayed value.

A notable feature of Claim 1 is that the consumer's computer simultaneously displays (1) an offer for sale of a product and/or service, and (2) an incentive to motivate the consumer to immediately make an electronic purchase by accepting the offer. To motivate the consumer, the incentive has a displayed value that changes with time. Therefore, the longer the consumer waits before, for example, clicking on the "BUY" button, the less favorable the displayed value of the incentive will be.¹

Barnett was discussed extensively in the Amendment filed on July 17, 2006. A key aspect of Barnett's system is that the system allows a consumer to download a coupon. Once the coupon is downloaded, it may be printed and redeemed by the consumer by physically presenting it at a retailer, or it may be electronically redeemed.

According to Barnett's printed-coupon redemption scheme, "the electronic coupon distribution system of the present invention allows the printing of a particular coupon only once, thus providing security and guarding against fraudulent redemption. This is accomplished by a coupon deletion routine 32e, which is called whenever a coupon is printed and acts to delete the coupon from a database 30 or to render it unprintable by setting an appropriate flag." (See column 11, lines 45-52.) The "actual expiration date is always printed as part of the coupon." (See column 11, lines 62-63.)

¹ The examples presented herein are intended for illustrative purposes only. It should be understood that the claimed invention is not limited to any details discussed in connection with the illustrative examples.

According to Barnett's electronic redemption scheme, a coupon may be redeemed electronically by "sending the coupon data in the output buffer via the data communications interface 20 back to the online service provider 2." This is illustrated by the dashed arrow towards the right-hand side of FIG. 1. Apparently, the online service provider 2 then transmits the electronic coupon to an Internet Web site, as illustrated in FIG. 1. Alternatively, the coupon data may be "routed via the data communications interface 20 to a retail store where the user will be shopping, where the coupon data is held in a buffer pending purchase by the user of the matching product." (See column 11, lines 40-44.)

Applicants respectfully submit that neither the printed-coupon redemption scheme nor the electronic redemption scheme involves concurrently displaying an offer for sale of a product and/or service and an incentive for making a prompt or immediate electronic purchase of the product and/or service, wherein the incentive has a displayed value that changes over time in order to urge a consumer to decide quickly to make the electronic purchase, as claimed in Claim 1. That is, as the consumer sees the displayed value of the incentive decreasing, the consumer is motivated to click on the "BUY" button to electronically purchase the product and/or service before the displayed value of the incentive decreases even further, for example.²

More specifically, Barnett fails to teach or suggest a "method for motivating a consumer to promptly purchase a product and/or service electronically over a computer network," wherein the method includes "providing from a server over the computer network to a consumer's computer a program that causes said consumer's computer to: (a) display an offer for

² For example, if the incentive is a discount off the price of the offer, then a decrease in the displayed value of the incentive would be seen as a decrease in the amount of the discount off the price of the offer. Also, for example, if the incentive is a "sale" price to purchase the offer, then a decrease in the displayed value of the incentive would be seen as an increase in the "sale" price to purchase the offer. The motivation for the consumer to electronically purchase the product and/or service arises from seeing the displayed value of the incentive decrease with time (e.g., seeing the amount of a discount decrease with time or seeing the sale price increase with time).

sale of a product and/or service that may be purchased immediately by said consumer via said computer network, (b) concurrently display an incentive for purchasing said product and/or service promptly, wherein said program causes said incentive to be initially set to an initial displayed value and then changes said incentive over a period of time to at least one other displayed value, and (c) when said consumer makes an electronic purchase of said product and/or service by electronically accepting said offer, provide to said server an indication of acceptance and a current displayed value of said incentive,” as recited in Claim 1.

The Advisory Action states that “in Barnett, the incentive and the service and product *can* be provided simultaneously by allowing the customer to purchase the products at the time that the coupons are requested, the customer *can* redeem the coupons electronically and redeem the coupons at the same session or same time.” (Emphasis added.) Applicants respectfully submit, however, that the mere possibility that Barnett’s system “can” perform a certain function does not by itself indicate that Barnett contemplated such a function or even recognized the value of such a function. It is now well established by the courts that it is improper to use hindsight analysis to reject a claim. That is, when the cited reference provides no suggestion or motivation for a feature, hindsight analysis may not be used to import the motivation from the applicant’s own disclosure in order to reject the applicant’s claim.

The Advisory Action states that “Barnett on col. 12, lines 9-16 teaches monitoring the time of the coupon’s download or acceptance time in order to determine or update or change the coupon’s amount.” Applicants respectfully disagree with this characterization of Barnett. The cited portion of Barnett states the following: “The coupon management program also can vary the redemption value of any coupon *already downloaded* to the user’s computer 6 *without the need for specific user interaction*. A coupon variation routine 32*f* is called which aids in this

task. Again *any time* that a user initiates a download of coupon data, the on-line service provider 2 can update redemption amounts for coupons whose issuers have decided to change the discount amount.” (Emphasis added.) Firstly, Applicants understand this portion of Barnett to teach that the value of the coupon can change without the user’s knowledge. This is contrary to the claimed invention, which wants the consumer to see the coupon change in value, so that the user is compelled to act quickly before the value of the coupon changes again. Secondly, Applicants understand this portion of Barnett to teach that the value of an “already downloaded” coupon may be changed by a coupon management program to another value that already has been “decided” by the issuer of the coupon. Applicants respectfully submit that this feature of Barnett teaches away from providing an incentive to make an immediate purchase, because apparently the value of the coupon does not change until after the coupon is downloaded, so the consumer would have no incentive to make an immediate purchase. Because the value of the coupon may go up or may go down (and apparently the consumer is not informed of which direction the change in the value of the coupon may take), there is no urgency or immediacy for the consumer to download the coupon and make an immediate purchase, especially if the consumer is content with the pre-download value of the coupon. That is, it would be more beneficial for the consumer to delay downloading the coupon in order to delay any change in its value, as predecided by the coupon’s issuer, because there is a possibility that the value of the coupon may go down or may go up. Therefore, Barnett’s system is believed to provide a disincentive to download a coupon and make an immediate purchase: first, the act of downloading the coupon initiates a possible change in value of the coupon to a lesser value or to a greater value, or the value of the coupon may stay the same--there is no way for the consumer to tell which direction the value of the coupon will go--; and second, because there is the possibility that the value of

the coupon may go up, the consumer may decide that it is more worthwhile to delay making the purchase in the hopes of an increase in the coupon's value.

Additionally, contrary to the characterization of Barnett presented in the Advisory Action, nothing in the cited portion of Barnett relates to "monitoring the time of the coupon's download or acceptance time." The cited portion of Barnett clearly states "any time," which is respectfully submitted to be different from comparing an initial time and an acceptance time. In fact, it is unclear what in Barnett would correspond to the initial time of Claim 1 and what in Barnett would correspond to the acceptance time of Claim 1. In Claim 1, the initial time is the time at which the incentive is initially displayed; and the acceptance time is the time at which the consumer accepts the displayed offer for sale, i.e., makes an electronic purchase.

Again, Barnett is not understood to teach or suggest that the value of the coupon changes over a period of time, but rather Barnett teaches that only after the coupon is downloaded can the value of the coupon change to a value that has been predecided by the issuer. Nothing has been found in Barnett that is believed to show or suggest that a displayed value of an incentive changes over a period of time to at least one other displayed value.

The Advisory Action states that Applicants are overlooking the "fair teachings" of Barnett. Applicants respectfully request clarification on what the Examiner believes are Barnett's "fair teachings." Although Applicants do not dispute that Barnett teaches a coupon system, Applicants respectfully submit that Barnett's coupon system operates in a way that is different from the method of Claim 1. Barnett fails to disclose every element of Claim 1 and therefore a *prima facie* case of anticipation has not been established.

Further, Applicants respectfully submit that an acceptance of an offer for sale is an agreement to make a purchase. An acceptance of an offer for sale is not merely an agreement to receive a coupon.

For at least the above reasons, Applicants submit that Claim 1 is not anticipated by Barnett. Independent Claims 30 and 36-39 include features similar to those of Claim 1 discussed above, including the feature of concurrently displaying (1) an offer for sale of a product and/or service, and (2) an incentive whose displayed value changes with time. Therefore, those claims also are believed to be patentable for at least the aforementioned reasons.

The other claims in this application depend from one or another of the independent claims discussed above and therefore also are submitted to be patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

Additionally, in regard to Claims 12 and 13, the Advisory Action states that “on Fig. 9, it teaches keeping track of coupon redemption in order to determine subsequent coupon sets. A new user (infrequent customer) will receive fixed coupon data and an existing user will receive more favorable incentives based on their coupon usage.” Applicants respectfully submit that nothing in Barnett or Fig. 9 relates to whether a customer is a frequent customer or an infrequent customer. Instead, Fig. 9 shows that when a customer is a first time customer (see the diamond in Fig. 9), then demographic data is obtained from the customer. No determination is made regarding frequency of use, i.e., how many times the customer downloads a coupon. In fact, according to Barnett, the demographic data of many customers is compiled and analyzed so that a certain *category* of customers is provided with subsequent packages according to their

demographic information. (See column 6, lines 52-64.) Also, Barnett apparently teaches away from giving repeat customers a more favorable incentive, as claimed in Claims 12 and 13; instead, Barnett discourages repeat customers by giving a customer a coupon for a product that is different from the product of the coupon previously downloaded by the customer, or by giving the customer a lower-value coupon for the product of the coupon previously downloaded by the customer. (See column 12, lines 48-53.)

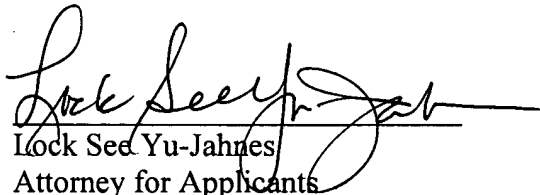
In view of the foregoing, Applicants respectfully request favorable consideration and early passage to issue of the present application. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case.

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CONCLUSION

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,


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